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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,366	04/22/2004	Akira Suga	03500.011729.2	6477

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FITZPATRICK CELLA HARPER & SCINTO
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NEW YORK, NY 10112

EXAMINER

CHIO, TAT CHI

ART UNIT	PAPER NUMBER
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2621

MAIL DATE	DELIVERY MODE
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11/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/829,366	Applicant(s) SUGA ET AL.	
	Examiner Tat Chi Chio	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28, 29, 32-36 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 28, 29, 32-36 and 39-41 is/are rejected.
- 7) ☒ Claim(s) 30, 31, 37, and 38 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/22/2004</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 40 and 41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 40 and 41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory matter as follows. Claims 40 and 41 define a storage medium and a program respectively embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded

on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of descriptive material to be realized"). That is, the scope of the presently claimed storage medium and a program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 28, 33, 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujimori (5,027,214).

Consider claims 28, 39, 40, and 41, Fujimori teaches a recording apparatus comprising: attribute data holding means for holding plural attribute data concerning image data or voice data (Fig. 4A and Fig. 4B); and recording means, when the image data or the voice data is recorded, for automatically associating predetermined attribute data from among the plural attribute data previously held by said attribute data holding means with the image data or the voice data and then performing the recording (col. 10,

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lines 48-66, the image data is automatically associated with the attribute data when it is recorded).

Consider claim 33, Fujimori teaches an apparatus, wherein the attribute data to be automatically associated with the image data includes designation of an image processing means (compression scheme of Fig. 4B).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimori (5,027,214) in view of Konishi et al. (5,579,502).

Consider claim 29, Fujimori teaches all the limitations in claim 28 but does not explicitly teach an apparatus, wherein the attribute data to be automatically associated is held on a nondetachable built-in recording medium.

Konishi et al. teach an apparatus, wherein the attribute data to be automatically associated is held on a nondetachable built-in recording medium (Fig. 3 and col. 21, line 49-col. 22, line 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to hold the attribute data on a nondetachable built-in recording medium to initialize the data format of the attribute data.

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5. Claims 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimori (5,027,214) in view of Sawyer (4,717,971).

Consider claim 32, Fujimori teaches all the limitations in claim 28 but does not explicitly teach an apparatus, further comprising input means for externally inputting or editing attribute information to be added to the data automatically associated when the image data or the voice data is recorded.

Sawyer teaches an apparatus, further comprising input means for externally inputting or editing attribute information to be added to the data automatically associated when the image data or the voice data is recorded (col. 10, line 61-col. 11, line 13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate an input means for externally editing attribute information to improve the apparatus to enable the user to edit information related to the image data.

Consider claim 35, Sawyer further teaches an apparatus, wherein the attribute data to be automatically associated with the image data includes arbitrary character information (col. 3, lines 56-67).

6. Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimori (5,027,214) in view of Kuba et al. (5,806,072).

Consider claim 34, Fujimori teaches all the limitations in claim 28 but does not explicitly teach an apparatus, wherein the attribute data to be automatically associated

with the image data includes information for designating setting of said recording apparatus.

Kuba et al. teach an apparatus, wherein the attribute data to be automatically associated with the image data includes information for designating setting of said recording apparatus (Fig. 86). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include information for designating setting of the recording apparatus to manage the image data in a highly efficient manner.

Consider claim 36, Kuba et al. further teach an apparatus, wherein the attribute data to be automatically associated with the voice data includes a setting name of said recording apparatus (Fig. 86).

Allowable Subject Matter

7. Claims 30, 31, 37, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tat Chi Chio whose telephone number is (571) 272-

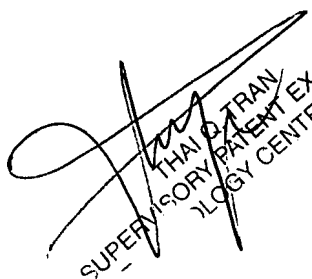
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9563. The examiner can normally be reached on Monday - Thursday 8:30 AM-6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on (571)-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TCC


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